

**REMARKS**

Claims 1-26 are pending. By this Response, claims 1, 3, 5, 6, 8, 10, and 18-21 have been amended. Reconsideration and allowance are respectfully requested.

Claims 1 and 2 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants traverse this rejection and respectfully assert that the rejected claims particularly point out and distinctly claim the subject matter which Applicants regard as the claimed invention. Specifically, claim 1 has been amended to explicitly recite a second communications terminal as suggested by the Examiner. Claim 1 is therefore not indefinite. Claim 2 has been rejected as being dependent from a rejected claim, and therefore also particularly points and distinctly claims the subject matter which Applicants regard as the claimed invention. Accordingly, Applicants request that the Examiner withdraw the instant rejection.

Claims 1, 2, 5-7, 10-13, 14, 16, 19 and 20 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,742,905 to Pepe et al. (Pat. '905). Applicants traverse this rejection and respectfully assert that Pat. '905 does not disclose all of the claimed limitations.

With specific regard to claims 1, 5, 6, 10, 19 and 20, Pat. '905 does not describe either a shopping list or a recipe as claimed. Rather, Pat. '905 is directed to facilitating communications in the business context (see column 1, lines 11-13). For example, Pat. '905 specifically discusses receiving and delivering voice and text messages, but makes no mention of data items that include shopping lists or recipes. For at least the above reasons, claims 1, 5, 6, 10, 19 and 20 are not anticipated by Pat. '905. Claims 2, 7, 11-14 and 16 depend from claims 1, 6 and 10, and therefore also recite patentable subject matter. As such, Applicants request that the Examiner withdraw the instant rejection.

Claim 17 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. '905. Applicants traverse this rejection and respectfully assert that Pat. '905 fails to satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the reference.

Specifically, Pat. '905 does not describe a shopping list or a recipe as recited in claim 10, from which claim 17 depends. As already noted, Pat. '905 is limited to receiving and delivering

text messages and demonstrates no appreciation for shopping lists or recipes. Indeed, the entire thrust of Pat. '905 is to support "mobile office" communications (see column 1, lines 15-17) by facilitating message retrieval. To the extent that the Examiner suggests that the messages of Pat. '905 inherently include a shopping list or a recipe, Applicants point out that the burden to show such inherency rests with the Examiner. Applicants also point out that the fact that a certain result or characteristic may occur or be present in a reference is not sufficient to establish the inherency of that result or characteristic. Furthermore, with regard to the recitation of an alphanumeric list of items in claim 17, Applicants seasonably challenge the Official Notice taken by the Examiner and request citation of references for all claimed features missing in Pat. '905, and motivation for combining any such features with Pat. '905. For at least the above reasons, claim 17 is patentable over Pat. '905. Accordingly, Applicants request that the Examiner withdraw the instant rejection.

Claims 3 and 4 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. '905 in view of U.S. Patent No. 6,295,530 to Ritchie et al. (Pat. '530). Applicants traverse this rejection and respectfully assert that Pat. '905 and Pat. '530 do not satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the references.

With specific regard to claim 3, Pat. '905 does not teach or suggest a shopping list or recipe as already discussed. The Examiner relies upon Pat. '530 to cure the deficiencies of Pat. '905 and specifically cites Pat. '530 for the alleged teaching of the indexing recited in claim 3. Applicants point out, however, that with regard to the claimed limitation of a shopping list or recipe is still not taught by the references. For example, Pat. '530 has the explicit goal of facilitating message delivery, whereas Pat. '530 is directed to improving the generation of structured web pages (see column 1, lines 9-12; column 5, lines 16-19). Because the two references each are directed to different goals and different objects, the art can support no implicit motivation to combine their teachings. There must be an express suggestion to combine these techniques before a hypothetical worker of ordinary skill would do so. For at least the above reasons, claim 3 is patentable over Pat. '905 and Pat. '530. Claim 4 depends from claim 3, and therefore also recites patentable subject matter. As such, Applicants request that the Examiner withdraw the instant rejection.

Claims 8 and 9 have been rejected under 35 U.S.C. §103 as being unpatentable over Pat. '905, in view of U.S. Patent No. 6,519,144 to Henrie et al. (Pat. '144) and further in view of Pat. '530. Applicants traverse this rejection and respectfully assert that Pat. '905, Pat. '144, and Pat. '530 fail to satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the references.

With specific regard to claim 8, Pat. '905 and Pat. '530 do not describe a shopping list or recipe as claimed. The Examiner relies upon Pat. '144 to cure the deficiencies of Pat. '905 and Pat. '530, and specifically cites Pat. '144 for the alleged teaching of storing data set records as recited in claim 8. Applicants point out, however, that the claimed limitation of a shopping list or recipe is still not taught by the references. For example, Pat. '144 is directed to a PDA cradle and demonstrates no appreciation for shopping lists or recipes. For at least the above reasons, claim 8 is patentable over Pat. '905, Pat. '144, and Pat. '530. Claim 9 depends from claim 8, and therefore also recites patentable subject matter. Accordingly, Applicants request that the Examiner withdraw the instant rejection.

Claim 15 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. '905, in view of U.S. Patent No. 5,485,519 to Weiss (Pat. '519). Applicants traverse this rejection and respectfully assert that Pat. '905 and Pat. '519 fail to satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the references.

Specifically, Pat. '905 does not describe a patent list or recipe as already discussed. The Examiner relies upon Pat. '519 to cure the deficiencies of Pat. '905 and specifically cites Pat. '519 for the alleged teaching of a portable token as recited in claim 15. Applicants point out, however, that the limitation of a shopping list or recipe is still not taught by the references. For example, Pat. '519 is directed to enhancing private key security and demonstrates no appreciation for the claimed shopping list or recipe. For at least the above reasons, claim 15 is patentable over Pat. '905 and Pat. 519. As such, Applicants request that the Examiner withdraw the instant rejection.

Claims 18, 21, 24 and 25 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. '905 as applied to claim 6, and further in view of U.S. Patent No. 6,496,692 to Shanahan (Pat. '692). Applicants traverse this rejection and respectfully assert

that Pat. '905 and Pat. '692 fail to satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the references.

With specific regard to claim 18, Pat. '905 does not describe a shopping list or recipe as recited in claim 6, from which claim 18 depends, as already discussed. The Examiner relies upon Pat. '692 to cure the deficiencies of Pat. '905 and specifically cites Pat. '692 for the alleged teaching of a video clip as recited in claim 18. Applicants point out, however, that the limitation of a shopping list recipe is still not taught by the references. For example, Pat. '692 demonstrates no appreciation for a shopping list or recipe. For at least the above reason, claim 18 is patentable over Pat. '905 and Pat. '692. With regard to claims 21, 24 and 25, Applicants direct the Examiner's attention to the discussion of claim 21 below. As such, Applicants request that the Examiner withdraw the instant rejection.

Claim 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. '905, Pat. '692 as applied to claim 21, and further in view of U.S. Patent No. 5,933,816 to Zeanah et al. (Pat. '816). Applicants traverse this rejection and respectfully assert that Pat. '905, Pat. '692 and Pat. '816 fail to satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the references.

Specifically, Pat. '905 does not describe a shopping list or recipe as already discussed. The Examiner relies upon Pat. '816 to cure the deficiencies of Pat. '905 and Pat. '692 and specifically cites Pat. '816 for the alleged teaching of conducting a transaction between a user of a selected data receiver as recited in claim 23. Applicants point out, however, that the limitation of a shopping list or recipe is still not taught by the references. For example, Pat. '816 is directed to the delivery of financial services and demonstrates no appreciation for shopping lists or recipes. Indeed, Pat. '816 is neither in the field of applicants' endeavor or reasonably pertinent to the particular problem with which the inventors were concerned and therefore represents nonanalogous art. For at least the above reasons, claim 23 is patentable over Pat. '905, Pat. '692 and Pat. '816. Accordingly, Applicants request that the Examiner withdraw the instant rejection.

Claim 26 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Pat. '905 and Pat. '692 as applied to claim 25, and further in view of U.S. Patent No. 6,424,749 to Zhu et al. (Pat. '749). Applicants traverse this rejection and respectfully assert that Pat. '905, Pat. '692

and Pat '749 fail to satisfy a *prima facie* case of obviousness because all of the claimed limitations are not taught or suggested by the references.

Specifically, Pat. '905 and Pat. '692 do not describe a shopping list or recipe as already discussed. The Examiner relies upon Pat. '749 to cure the deficiencies of Pat. '905 and Pat. '692 and specifically cites Pat. '749 for the alleged teaching of a carrier bearing a computer program as recited in claim 26. Applicants point out, however, that the limitation of a shopping list or recipe is still not taught by the references. For example, Pat. '749 is directed to scaling combined video and computer generated imagery and demonstrates no appreciation for shopping lists or recipes. For at least the above reasons, claim 26 is patentable over Pat. '905, Pat. 692 and Pat. 749. As such, Applicants request that the Examiner withdraw the instant rejection.

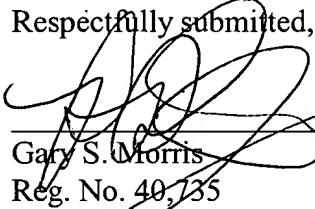
### CONCLUSION

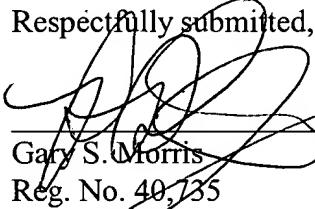
Applicants submit that all pending claims are in condition for allowance. Accordingly, Applicants respectfully request the Examiner to pass this case to issue at his or her earliest possible convenience.

The Commissioner is hereby authorized to charge any additional fees required or credit any overpayment in connection with this correspondence to Deposit Account 11-0600.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (202) 220-4275.

Respectfully submitted,

  
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